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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,901	11/29/2001	Richard D. Ellis	130081	4144

52531 7590 11/12/2009

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EXAMINER	
BEKERMAN, MICHAEL	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
11/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/998,901	ELLIS ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-31,33-37 and 39-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-31,33-37 and 39-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/9/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 6/17/2009.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 35 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 35 and 41, these claims recite the limitation "thresholds that are greater than zero". Applicant's specification lacks a recitation directed to which exact thresholds should or should not be considered when incrementing a hit count. There is no support for the exclusion of a threshold of zero anywhere in the specification as originally filed. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.04(i).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 44, this claim recites the limitation "packets filled with nonvaluable data". The term "nonvaluable" is a relative term which renders the claim indefinite. The term "nonvaluable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since each human being views value differently, how does one determine if certain data is "valuable" or "nonvaluable"?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 37, 39-41 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Heckel (U.S. Patent No. 6,036,601).** Heckel teaches a system and

method of placing advertising in games that includes all of the limitations recited in the above claims.

Regarding claims 37 and 43, Heckel teaches establishing a communication link with a user system running a game (since the user logs in, the user computer is indeed running the game) and receiving from the user system a request for advertising meeting certain criteria (Column 4, Lines 35-58), retrieving at least one advertisement that meets the certain criteria and transmitting it to the user system (Column 4, Lines 46-53). Merriam Webster's New Riverside Dictionary defines "continual" as "recurring regularly and frequently". Heckel teaches advertisements as being transmitted regularly multiple times (at least between game levels) (Column 4, Lines 35-58 and Column 5, Lines 16-28), and this reads on “continually” transmitting data until the system stops running the video game.

Regarding claims 39-41, Heckel teaches receiving quality data from the user system regarding time the advertisement is displayed (duration), the type of views (manner), the number of times displayed, and the size in terms of pixels (Column 5, Lines 10-15). Since both time and pixel-size is measured and presented, this represents "pixel-hours". The number of times an ad is displayed represents a "hit-count", with the number being incremented every time the size or time of an ad meets any threshold greater than "0" (meaning the ad has been shown).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 26-30, 33-35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601).**

Regarding claims 26 and 42, Heckel teaches establishing a connection to a game server and an ad server (Figure 1), receiving advertisements over a network and storing them on a user system (Column 4, Lines 35-58), each advertisement having a “content” (images, Column 3, Lines 61-63) and an "attribute" (at least demographic impressions and intended target audience, Column 4, Lines 8-9), detecting a tag (plug-in) in which to place the advertisement, and determining, by the tag running on the client system, an “appropriate” (matching appropriate criteria of the tag) advertisement to place (Column 5, Lines 5-8). This functionality is implemented when the user logs onto the game server (Beginning at Column 4, Line 35), and thus, occurs while the game code is executing (when a user logs on, the game code is executing, and when the game code is executing, the game is being played). Merriam Webster's New Riverside Dictionary defines "continual" as "recurring regularly and frequently". Heckel teaches advertisements as being transmitted regularly multiple times (at least between game levels) (Column 4, Lines 35-58 and Column 5, Lines 16-28), and this reads on

continually transmitting data until the system stops running the video game (over a remaining duration or game execution).

Heckel does not appear to specify exactly which criterion is used by the tag to determine an appropriate advertisement. However, Heckel does already teach the functionality to determine appropriate advertisements for downloading to the user system before the tag selects an advertisement for insertion (Column 4, Lines 35-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to program the tag to use the same functionality already disclosed in Heckel to select the appropriate ad texture. This act of double-checking the appropriateness of the advertisement by the tag would result in less advertisement selection error and more advertisements reaching their correct targeted audience.

Regarding claim 27, Heckel teaches targeting criteria as comprising a minimum age group (Column 3, Line 65 – Column 4, Line 2).

Regarding claim 28, Heckel teaches advertisements that have subject matter and genre targeted towards male-oriented ads or female-oriented ads, as well as advertising subject matter and genre for numerous other demographics (Column 4, Lines 5-8). This is taken to read on defining a genre and a desired subject matter (a subject matter and genre for one demographic category would be different for others).

Regarding claims 29 and 30, Heckel teaches the ad server as sending advertisements correlated to different formats and shapes (Column 3, Lines 58-65), the formats including images and video clips (Column 5, Lines 3-5).

Regarding claims 33-35, Heckel teaches receiving quality data from the user system regarding time the advertisement is displayed (duration), the type of views (manner), the number of times displayed, and the size in terms of pixels (Column 5, Lines 10-15). Since both time and pixel-size is measured and presented, this represents "pixel-hours". The number of times an ad is displayed represents a "hit-count", with the number being incremented every time the size or time of an ad meets any threshold greater than "0" (meaning the ad has been shown).

Regarding claim 44, Heckel teaches sending more advertisements, thus maintaining a continual receipt of data (Column 4, Lines 35-58 and Column 5, Lines 16-28). Advertisements that users don't happen to be interested in would not be considered "valuable". Therefore, depending on the person and the advertisement, ads could be nonvaluable and this reads on the claim language.

5. **Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Hunter (U.S. Pub No. 2002/0156858).**

Regarding claim 31, while Heckel teaches logging times at which an advertisement was displayed, Heckel does not appear to specify scheduling advertisements for specific time slots. Hunter teaches a system and method in which advertisers reserve specific time slots in which to display advertising (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow advertisers to schedule time slots for advertising (and thus have the tags show the advertising meeting the time slot reservation requirements).

Advertisers may be willing to pay more money for specific time slots as opposed to general ones, which would garner more advertising revenue.

6. **Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Spaur (U.S. Patent No. 6,196,920).**

Regarding claim 36, Heckel does not appear to specify the ability to interact with the presented advertisement. Spaur teaches a card game in which advertisements are placed on the back of cards (Column 15, Lines 20-27). When a card having an advertisement thereon is interacted with, the card (game object) will move to a different area of the screen, which reads on modifying an interactive game behavior of a game object. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to interact with the advertisement. This increased interactive functionality will provide a greater chance of a user noticing and viewing the advertisement. The claim language following the term "such that" is not actively claimed as taking place and is being viewed as intended use (one step occurs "such that", or "in the hopes that" another step will happen, however the second step is not guaranteed to happen even if it is intended to). Therefore, this claim language is not required.

ALTERNATIVE Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

While the game user is logged into the game server and entering personal information is considered to be engaging the game, and thus, playing the game, an argument could be made that this does not constitute actual game play. Examiner recognizes this argument as merely an interpretational issue, and in the interest of a thorough examination, will supply the following 103 rejection to cover such an interpretation.

7. **ALTERNATIVELY, Claims 26-30, 33-35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Spaur (U.S. Patent No. 6,196,920).**

Regarding claims 26 and 42, Heckel teaches establishing a connection to a game server and an ad server (Figure 1), receiving advertisements over a network and storing them on a user system (Column 4, Lines 35-58), each advertisement having a “content” (images, Column 3, Lines 61-63) and an "attribute" (at least demographic impressions and intended target audience, Column 4, Lines 8-9), detecting a tag (plug-in) in which to place the advertisement, and determining, by the tag running on the client system, an “appropriate” (matching appropriate criteria of the tag) advertisement to place (Column 5, Lines 5-8). Merriam Webster's New Riverside Dictionary defines "continual" as "recurring regularly and frequently". Heckel teaches advertisements as being transmitted regularly multiple times (at least between game levels) (Column 4, Lines 35-58 and Column 5, Lines 16-28), and this reads on continually transmitting data

until the system stops running the video game (over a remaining duration of game execution).

Heckel does not appear to specify exactly which criterion is used by the tag to determine an appropriate advertisement. However, Heckel does already teach the functionality to determine appropriate advertisements for downloading to the user system before the tag selects an advertisement for insertion (Column 4, Lines 35-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to program the tag to use the same functionality already disclosed in Heckel to select the appropriate ad texture. This act of double-checking the appropriateness of the advertisement by the tag would result in less advertisement selection error and more advertisements reaching their correct targeted audience.

It could be argued that Heckel does not teach the downloading and placing of advertisements while a game is being played. Spaur, however, teaches requesting such advertising content for display while the user is playing the game (Column 8, Lines 43-46). One of ordinary skill would have recognized that applying the known technique of downloading and placing advertisements during game play would have yielded predictable results and resulted in an improved system.

Regarding claim 27, Heckel teaches targeting criteria as comprising a minimum age group (Column 3, Line 65 – Column 4, Line 2).

Regarding claim 28, Heckel teaches advertisements that have subject matter and genre targeted towards male-oriented ads or female-oriented ads, as well as advertising subject matter and genre for numerous other demographics (Column 4,

Lines 5-8). This is taken to read on defining a genre and a desired subject matter (a subject matter and genre for one demographic category would be different for others).

Regarding claims 29 and 30, Heckel teaches the ad server as sending advertisements correlated to different formats and shapes (Column 3, Lines 58-65), the formats including images and video clips (Column 5, Lines 3-5).

Regarding claims 33-35, Heckel teaches receiving quality data from the user system regarding time the advertisement is displayed (duration), the type of views (manner), the number of times displayed, and the size in terms of pixels (Column 5, Lines 10-15). Since both time and pixel-size is measured and presented, this represents "pixel-hours". The number of times an ad is displayed represents a "hit-count", with the number being incremented every time the size or time of an ad meets any threshold greater than "0" (meaning the ad has been shown).

Regarding claim 36, Heckel does not appear to specify the ability to interact with the presented advertisement. Spaur teaches a card game in which advertisements are placed on the back of cards (Column 15, Lines 20-27). When a card having an advertisement thereon is interacted with, the card (game object) will move to a different area of the screen, which reads on modifying an interactive game behavior of a game object. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to interact with the advertisement. This increased interactive functionality will provide a greater chance of a user noticing and viewing the advertisement. The claim language following the term "such that" is not actively claimed as taking place and is being viewed as intended use (one step occurs "such

that", or "in the hopes that" another step will happen, however the second step is not guaranteed to happen even if it is intended to). Therefore, this claim language is not required.

8. **ALTERNATIVELY, Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Spaur (U.S. Patent No. 6,196,920), and further in view of Hunter (U.S. Pub No. 2002/0156858).**

Regarding claim 31, while Heckel teaches logging times at which an advertisement was displayed, Heckel does not appear to specify scheduling advertisements for specific time slots. Hunter teaches a system and method in which advertisers reserve specific time slots in which to display advertising (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow advertisers to schedule time slots for advertising (and thus have the tags show the advertising meeting the time slot reservation requirements). Advertisers may be willing to pay more money for specific time slots as opposed to general ones, which would garner more advertising revenue.

Response to Arguments

9. Applicant's amendments to claim 37 appear to have overcome the 101 rejection. All steps are believed to be performed by the ad server, and the step of retrieving an advertisement that matches desired criteria is believed to be significant.

10. **Applicant argues** “there is no disclosure or suggestion in Heckel that this demographic data is ever transferred by the ad server or game server to a game client system as part of an advertisement”. To match demographics to advertisements, the advertisements must have some inherent data attribute. In other words, "people over the age of 25 would like this ad" is an "attribute" of the advertisement. When system requests an advertisement for someone over 25, the system checks ad attributes which match the demographic profile. This limitation is believed to be taught by Heckel for these reasons.

11. **Applicant argues** “Heckel only discloses such transfers taking place before game play or during breaks in game play". Examiner would like to submit the following example. A person playing a Nintendo Entertainment System (NES) gaming console puts in a gaming cartridge and powers on the unit. When the player begins interacting with the game through the gaming pad, that person is playing the game. If the player is required to enter personal information at the beginning of the game, such as a name or a "continue code", the person is still "playing the game". Since the game software is running on the NES, much like the software of Heckel is running on the client computer, the user is effectively playing the game. The portion of the game that the user is playing is not specified in the claim language. Thus, while Heckel uses the language "play will commence", the user is still, in fact, playing the game upon entering user information.

12. All other arguments are believed to have been addressed by the amended rejections above.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Examiner, Art Unit 3622